

**REMARKS**

This is in response to the Office Action of March 8, 2007. Applicants gratefully acknowledge the indicated allowability of claims 25-27. Claim 10 is rewritten in independent form. No new matter is introduced by this Amendment. Claims 1, 2, 6-8, 10, 13-16, 19, 20, 25-27, and 29-32 are pending in the application.

Claims 10, 15, 16, and 20 are rejected under 35 U.S.C. § 102 as being anticipated by WO 94/25482. Office Action, pages 2-4. Claims 10, 15, 16, and 20 are rejected under 35 U.S.C. § 102 as being anticipated by JP09301888A. Office Action, pages 4-5. Claims 10, 15, 16, and 20 are rejected under 35 U.S.C. § 102 as being anticipated by JP10087509A. Office Action, pages 5-6. The basis for each of these rejections involves the Examiner's assertion that the references in question disclose the sequence Tyr-Pro-Asp-Glu-Ile-Glu-Tyr-Ile-Phe-Lys-Pro-Ser. However, the instantly rejected claims are limited to the sequences Gln-Pro-Val-Leu-His-Leu-Val-Ala-Leu-Asn-Thr-Pro-Leu, Val-Pro-Ile-Val-Asn-Leu-Lys-Asp-Glu-Val-Leu-Ser-Pro-Ser, and His-Pro-Ala-Trp-Pro-Gln-Lys-Ser-Val-Trp-His-Gly-Ser-Asp-Pro-Ser. It is not seen that the sequence noted by the Examiner anticipates any of claims 10, 15, 16, and 20.

Claims 1, 2, 6-8, 13, 14, 19, and 29 are rejected under 35 U.S.C. § 102 as being anticipated by WO 94/25482. Office Action, pages 2-4. Claims 1, 2, 6-8, 13, 14, 19, and 29 are rejected under 35 U.S.C. § 102 as being anticipated by JP09301888A. Office Action, pages 4-5. Claims 1, 2, 6-8, 13, 14, 19, and 29 are rejected under 35 U.S.C. § 102 as being anticipated by JP10087509A. Office Action, pages 5-6. The rejections are respectfully traversed.

A fundamental feature of all of the peptides involved in the present claims is that they comprise "a portion of an endostatin protein". Nothing in the Examiner's statement of the rejections explains how that feature of Applicants' invention as claimed is allegedly met by any of the references cited. Accordingly, the Examiner has failed to state a sustainable rejection of any of the claims in question.

Another feature of all of the instantly rejected claims is the requirement that the peptides exhibit an  $IC_{50}$  of 20  $\mu$ M or less in a bovine aorta endothelial cell proliferation assay or exhibit inhibition of angiogenesis in a chick chorioallantoic membrane assay of at least 30% at a dose of 50  $\mu$ g/coverslip. The Examiner argues that these features are inherent in the reference disclosures. However, to serve as an anticipation where, as here, the reference is silent about the asserted inherent characteristic, the gap in the reference must be filled. It may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA Inc. v. Monsanto Co.*, 20 USPQ2d 1746 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Hansgirk v. Kemmer*, 40 USPQ 665, 667 (CCPA 1939) (emphasis in original). The Examiner here has not established that persons of ordinary skill in the art would have recognized that the reference peptides exhibit an  $IC_{50}$  of 20  $\mu$ M or less in a bovine aorta endothelial cell proliferation assay or exhibit inhibition of angiogenesis in a chick chorioallantoic membrane assay of at least 30% at a dose of 50  $\mu$ g/coverslip. For this reason too the rejection of record is not believed to be sustainable.

In view of the above, the Examiner is requested to withdraw the rejections of record and to pass this application to Issue. If he would like to discuss any issues concerning this application, the Examiner is invited to telephone Richard Gallagher (Registration No. 28,781) at (703) 205-8008.

If necessary, the Commissioner is hereby authorized to debit Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §1.16 or §1.17, particularly extension of time fees.

Dated: June 8, 2007

Respectfully submitted,

By

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